REMARKS

Applicant appreciates the Office's review of the present application. In response to the Office Action, the cited references have been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file in the present application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

In order to render the claims more clear and definite, and to emphasize the patentable novelty thereof, claims 1, 5, 9, 19, 22, 30, and 31 have been amended, claim 27 has been cancelled without prejudice, and new claims 32-38 have been added. Support for any claim amendments and new claims is found in the specification, claims, and drawings as originally filed, and no new matter has been added. Accordingly, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested.

Rejections

Rejection Under 35USC §103

Claims 5-12 and 28 have been rejected under 35 USC §103(a), as being unpatentable over U.S. patent application publication 2003/0135381 to Mathiesen et al. ("Mathiesen"). Applicants respectfully traverse the rejection and request reconsideration.

As to a rejection under §103(a), the U.S. Patent and Trademark Office ("USPTO") has the burden under §103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988)*. The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

The rejection of independent claim 9, and its dependent claims 10-12, is respectfully traversed for at least the following reasons. Claim 9 recites:

"9. (Currently amended) An imaging device comprising:

a memory comprising computer-executable instructions for distributing metrics information corresponding to imaging operations;

a processor that is operatively coupled to the memory, the processor being configured to fetch and execute the computer-executable instructions from the memory, the computer-executable instructions comprising instructions for:

receiving, by the imaging device, a command to perform an imaging operation;

performing, by the imaging device, the imaging operation; and

responsive to performing the imaging operation, <u>communicating, by the imaging device, metrics information corresponding to the imaging operation directly to a second device without communicating through any intermediate device</u>, the metrics information for access by an application on a third device, such that the application on the third device can access the metrics information without forwarding any request for the metrics information to the imaging device." (emphasis added)

The Office has not established a *prima facie* case of obviousness at least because the applied references do not teach or suggest all of Applicant's claim limitations.

Claim 9 has been amended to recite that the imaging device communicates metrics information <u>directly</u> to a second device <u>without communicating through any intermediate device</u>, from which the metrics information can be accessed by an application on a third device without forwarding any request for the metrics information to the imaging device.

The Office states, with regard to the Mathiesen reference, that:

"Once the imaging operation is completed, the metrics information is communicated to a

second device (remote monitoring server, See Figure 1, Element 150) for access by an application on a third device" (Office Action, pp.2-3).

The Office further states that:

"Applicant also argues that the metrics information, as disclosed by Mathiesen, is not received at the remote monitoring server from the imaging device, but instead from the server. Mathiesen discloses within Page 2, Paragraph 0017 that 'the remote monitoring server 150 may be adapted to automatically monitor conditions at the server computer 130 and the at least one printer 140, 142.' Thus, the remote monitoring computer, and not the server computer, receives the metrics information from the printer" (Office Action, p.13; emphasis added).

Applicant respectfully disagrees, and believes that the Office mischaracterizes the teachings of the Mathiesen reference by taking paragraph [0017] out of context and employing impermissible hindsight based on Applicant's invention. An accurate understanding of what Mathiesen teaches with regard to the operation of the remote monitoring server 150 also requires reference to paragraphs [0015]-[0016], and the relationship between the remote monitoring server 150, server 130, and printers 140,142 as illustrated in Figure 1:

"The server computer 130 is connected to at least one printer 140, 142 and to a remote monitoring server 150. ...
The server computer 130 also has a connection to the remote monitoring server 150. The connection may be via the Internet, a high-speed modem, or any other suitable connection. The server computer 130 preferably executes customized software provided by a service provider or lessor to assist the remote monitoring server 150 to monitor the server computer 130 and/or the at least one printer 140, 142. The remote monitoring server 150 may monitor a number of conditions remotely, including the operation and status of the server computer 130, the operation and status of the printer(s) 140, 142, the ink levels of each ink cartridge (or the toner levels in each toner cartridge) in each printer 140, 142, the contents (full, empty, type of media, size, etc.) of a print media tray(s) of each printer 140, 142, and the number of print media units printed by each printer 140, 142." (para. [0015]-[0016]; emphasis added).

Figure 1, which paragraphs [0015]-[0017] describe, unambiguously shows that remote monitoring server 150 communicates only with server computer 130, and printers 140,142 likewise communicate only with server computer 130. Thus, it is clear that the remote monitoring server 150 does not directly communicate with printers 140,142. Rather, to the extent that remote monitoring server 150 communicates with printers 140,142 at all, it does so

only indirectly, through server computer 130.

There is no teaching anywhere in the Mathiesen reference that the remote monitoring server 150 is connected directly to printers 140,142. Therefore, for the reasons discussed herein, the applied references do not teach or suggest all of Applicant's claim limitations.

Applicant respectfully traverses the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicant's invention. Such could be possible only in hindsight and in light of Applicant's teachings. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Independent claim 5 (currently amended) recites limitations similar to those of claim 9, discussed above.

Claim 5 recites:

"5. (Currently amended) In a distributed computing environment, a computer-readable medium comprising computer-executable instructions for distributing peripheral device metrics information, the computer-executable instructions comprising instructions for:
    receiving, by an imaging device, a command to perform an imaging operation;
    performing, by the imaging device, the imaging operation; and
    responsive to performing the imaging operation, communicating, by the imaging device, metrics information corresponding to the imaging operation directly to a second device without communicating through any intermediate device, the metrics information for access by an application on a third device, such that the application on the third device can access the metrics information without forwarding any request for the metrics information to the imaging device."
(emphasis added)

For similar reasons as explained heretofore with regard to claim 9, the features of the present invention are not taught or suggested by the cited references in that the features by which the imaging device communicates metrics information corresponding to the imaging operation directly to a second device without communicating through any intermediate device are neither taught nor suggested by the Mathiesen reference.

Applicant respectfully traverses the Office's assertion that it would have been obvious to

a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicant's invention. Such could be possible only in hindsight and in light of Applicant's teachings. Therefore, the rejection of independent claim 5, and its dependent claims 6-8 and 28, is improper at least for that reason and should be withdrawn.

Claims 1-4, 19-22, and 29 have been rejected under 35 USC §103(a), as being unpatentable over U.S. patent application publication 2003/0135381 to Mathiesen et al. ("Mathiesen") in view of U.S. patent 5,802,420 to Garr et al. ("Garr"). Applicants respectfully traverse the rejection and request reconsideration.

The rejection of independent claim 1, and its dependent claims 2-4, is respectfully traversed for at least the following reasons. Claim 1 recites:

"1. (Currently amended) In a distributed computing environment, a method for distributing peripheral device operational metrics information, the method comprising:
        receiving, by an imaging device, a command to perform an imaging operation;
        responsive to receiving the command, performing, by the imaging device, the imaging operation; and
        responsive to performing the imaging operation, <u>communicating, by the imaging device, metrics information corresponding to the imaging operation directly to a second device without communicating the metrics information through any intermediate device</u>;
        receiving, at the second device, a request from a third device to access the metrics information; and
        responsive to receiving the request, providing access to the metrics information to the third device without the third device communicating with the imaging device." (emphasis added)

The Office has not established a *prima facie* case of obviousness at least because the applied references do not teach or suggest all of Applicant's claim limitations.

With regard to the communicating limitation, the Office relies on the Mathiesen reference for similar reasons as discussed heretofore with regard to claim 9. Applicant respectfully disagrees that the Mathiesen reference teaches this limitation, also for similar reasons as discussed heretofore with regard to claim 9. The Office does not cite the Garr reference as teaching such a limitation, and Applicant believes the Garr reference teaches no such limitation.

Thus all the limitations of claim 1, including the features by which the imaging device communicates metrics information corresponding to the imaging operation directly to a second device without communicating through any intermediate device, are neither taught nor suggested by the Mathiesen reference in combination with the Garr reference.

Furthermore, the Office has not established a *prima facie* case of obviousness at least because there is no suggestion or motivation to modify the reference or to combine reference teachings. With regard to the motivation for combining the Mathiesen and Garr references, the Office states that "by having a host computer view the metrics information, a user is able to request and view the combined metrics information used on multiple printers ... from the server instead of accessing a single printer to access the metrics information" (Office Action, p.6).

However, Applicant believes that the tradeoffs involved in combining the Mathiesen and Garr references, assuming arguendo that such a combination is feasible, are not desirable as a whole. "Trade-offs often concern what is feasible, not what is, on balance, desirable. Motivation to combine requires the latter" *Winner Int'l Royalty Corp. v. Wang, 53 USPQ2d 1580, 1587.* The "gas gauge" application program (Fig. 7) running on the host computer of the Garr reference illustrates the remaining toner for a single printer connected to the host computer. However, it is well known for computers to selectively access more than one printer, whether the printers are connected via a network, or via plural direct connections to the host computer. In order to view the toner status of multiple printers, the application program of Fig. 7 might require modifications not taught or suggested by either of the combined references. Assuming arguendo that these modifications could be made, the same capability must be provided in the application program regardless of whether the host computer is directly connected to multiple printers, or whether the host computer is connected to the remote monitoring server 150 of the Mathiesen reference. However, the tradeoffs that would be involved in using a remote monitoring server as in the Mathiesen reference, instead of direct printer connections, are undesirable on balance.

Adding an additional remote monitoring server computer as taught by the Mathiesen reference to the host computer of the Garr reference would require considerable expense and add significant software and network complexity. The same capability could be provided at much lower cost (i.e. completely eliminating the remote monitoring server computer 150) and much more simply merely by directly connecting multiple printers to the host computer of the Garr reference. Therefore, the tradeoffs involved in combining the Mathiesen and Garr references are not desirable as a whole.

Applicant respectfully traverses the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicant's invention. Such could be possible only in hindsight and in light of Applicant's teachings. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Independent claim 19 (currently amended) recites limitations similar to those of claim 1, discussed above. Claim 19 recites:

"19. (Currently amended) In a distributed computing environment, a computer-readable medium comprising computer-executable instructions for providing real-time imaging metrics information, the computer-executable instructions comprising instructions for:
receiving, at a server device, imaging operational metrics corresponding to an imaging operation directly from an imaging device, the imaging operation having been performed by the imaging device;
receiving, at the server device, a request from an application program for at least a portion of the imaging operational metrics, the application program executing on another device different from the imaging device and the server device; and
communicating the at least a portion of the imaging operational metrics from the server device to the application program." (emphasis added)

The Office considers the remote monitoring server 150 of the Mathiesen reference to be the server device recited in claim 19. For similar reasons as explained heretofore with regard to claim 9, the remote monitoring server 150 does not receive the imaging operational metrics corresponding to an imaging operation directly from an imaging device (i.e. printer 140,142), but

rather receives the metrics indirectly, from server 130. The Office does not cite the Garr reference as teaching such a limitation, and Applicant believes the Garr reference teaches no such limitation. Thus all the limitations of claim 19, including the features by which the server receives imaging operational metrics directly from an imaging device, are neither taught nor suggested by the Mathiesen reference in combination with the Garr reference. In addition, the Office has not established a *prima facie* case of obviousness at least because there is no suggestion or motivation to modify the reference or to combine reference teachings, for similar reasons as explained heretofore with regard to claim 1.

Applicant respectfully traverses the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicant's invention. Such could be possible only in hindsight and in light of Applicant's teachings. Therefore, the rejection of independent claim 19, and its corresponding dependent claims 20-21 and 29, is improper at least for that reason and should be withdrawn.

Independent claim 22 (currently amended) recites limitations similar to those of claim 1, discussed above. Claim 22 recites:

"22. (Currently amended) A server comprising:
a memory comprising computer-executable instructions for providing real-time imaging metrics information;
a processor that is operatively coupled to the memory, the processor being configured to fetch and execute the computer-executable instructions from the memory, the computer-executable instructions comprising instructions for:
receiving, at the server, an unsolicited set of imaging operational metrics corresponding to an imaging operation directly from an imaging device, the imaging operation having been performed by the imaging device;
receiving, at the server, a request from an application program for at least a portion of the imaging operational metrics, the application program executing on another device different from the imaging device and the server; and
communicating the at least a portion of the imaging operational metrics to the application program." (emphasis added)

The Office considers the remote monitoring server 150 of the Mathiesen reference to be the server device recited in claim 22. For similar reasons as explained heretofore with regard to claim 9, the remote monitoring server 150 does not receive the imaging operational metrics corresponding to an imaging operation <u>directly</u> from an imaging device (i.e. printer 140,142), but rather receives the metrics indirectly, from server 130. In addition, there is no teaching in the Mathiesen reference that the imaging operational metrics are <u>unsolicited</u>. In fact, the Mathiesent reference teaches just the opposite, that the metrics are solicited by the remote monitoring server 150 in that the server 150 monitors (through server 130) the operation and status of printers 140,142. The Office does not cite the Garr reference as teaching such limitations, and Applicant believes the Garr reference teaches no such limitations.

Thus all the limitations of claim 22, including the features by which the server receives an unsolicited set of imaging operational metrics directly from an imaging device, are neither taught nor suggested by the Mathiesen reference in combination with the Garr reference. In addition, the Office has not established a *prima facie* case of obviousness at least because there is no suggestion or motivation to modify the reference or to combine reference teachings, for similar reasons as explained heretofore with regard to claim 1.

Applicant respectfully traverses the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicant's invention. Such could be possible only in hindsight and in light of Applicant's teachings. Therefore, the rejection of independent claim 22 is improper at least for that reason and should be withdrawn.

Claims 23 and 30-31 have been rejected under 35 USC §103(a), as being unpatentable over U.S. patent application publication 2003/0135381 to Mathiesen et al. ("Mathiesen") in view of U.S. patent 5,802,420 to Garr et al. ("Garr"), and further in view of U.S. patent 6,762,854 to Murakami et al. ("Murakami"). Applicants respectfully traverse the rejection and request reconsideration.

The rejection of independent claim 31 is respectfully traversed for at least the following reasons. Claim 31 recites:

"31. (Currently amended) In a distributed computing environment, a method for providing real-time imaging metrics information, the method comprising:
receiving, at a server device, imaging metrics corresponding to an imaging operation directly from an imaging device, the imaging operation having been performed by the imaging device;
receiving, at the server device, a registration request from an application program for the server to provide the imaging metrics to the application program when the imaging metrics are updated responsive to the imaging device performing the imaging operation;
responsive to the registration request, configuring the server device to automatically communicate the at least a portion of the imaging metrics to the application program; and
responsive to receiving the imaging metrics, automatically communicating at least a portion of the imaging metrics to the application program." (emphasis added)

The Office has not established a *prima facie* case of obviousness at least because the applied references do not teach or suggest all of Applicant's claim limitations.

The Office considers the remote monitoring server 150 of the Mathiesen reference to be the server device recited in claim 31. For similar reasons as explained heretofore with regard to claim 9, the remote monitoring server 150 does not receive the imaging metrics corresponding to an imaging operation <u>directly</u> from an imaging device (i.e. printer 140,142), but rather receives the metrics indirectly, from server 130. The Office does not cite the Garr or Murakami references as teaching such limitations, and Applicant believes these references teach no such limitations.

In addition, while the Office admits that the Mathiesen reference does not disclose the limitations of the receiving a registration step, the Office states that the Murakami reference discloses "a utility program (on a host computer ...) that sends a registration requesting to access the metrics information" (Office Action, p.12). The referenced section of the Murakami reference teaches as follows:

"In this embodiment, the status of the remaining toner amount, exactly determined in the foregoing embodiments, is returned to the host computer 3000 either periodically, or <u>in response to a request for the status</u>, or at a timing designated by the user or by the host computer 3000, and

the host computer 3000 displays such status either periodically, or continuously, or at a timing designated by the user through an application a utility program or the operation panel of the printing apparatus." (col. 9, lines 46-54; emphasis added)

Applicant respectfully disagrees that the Murakami reference teaches <u>a registration request from an application program received at the server</u>, as recited in claim31. With regard to the registration request, Applicant's specification teaches:

"The application may also register with the server to automatically receive imaging device operational metrics from the server whenever those metrics information are updated (e.g., uploaded from the imaging device to the server for the first time or periodically updated responsive to image device operations). For instance, instead of polling or querying the server for imaging device operational metrics, the server can dynamically communicate any received imaging device operational metrics to the application in response to metric information having been communicated to the server by an imaging device." (specification, p.4, lines 15-23)

The Murakami reference teaches no such registration request. The request of the Murakami reference is merely a status request (i.e. a query issued to the device by the host computer 3000), to which the status is provided from the device in response.

Furthermore, the Murakami reference does not teach that the imaging metrics are provided to the server <u>when they are updated responsive to the imaging device performing the imaging operation</u>. In the Murakami reference, the imaging metrics are provided whenever the host computer requests them.

The Office does not cite the Garr reference as teaching such limitations, and Applicant believes the Garr reference teaches no such limitations. Therefore, for the reasons discussed herein, the applied references do not teach or suggest all of Applicant's claim limitations.

Furthermore, the Office has not established a *prima facie* case of obviousness at least because there is no suggestion or motivation to modify the reference or to combine reference teachings. The Office states that the Murakami and Mathiesen references can be combined together because updated metrics can then be used in an application. Applicant believes that this is too vague and not specific enough to ascertain a motivation in one or the other for combining. Consequently, this rationale impermissibly uses the Applicant's disclosure as a blueprint or in

hindsight for the rejection.

Applicant respectfully traverses the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicant's invention. Such could be possible only in hindsight and in light of Applicant's teachings. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Dependent claims 23 and 30 each recite limitations similar to those of claim 31, discussed above.

Claim 23 recites:

"23. (Previously presented) A method as recited in claim 1, wherein the request from the third device to access the metrics information is <u>a registration request to automatically receive the metrics information whenever the metrics information is updated</u>, and wherein the providing access to the metrics information to the third device includes the second device communicating the metrics information to the third device when the imaging device communicates updated metrics information to the second device." (emphasis added)

Claim 30 recites:

"30. (Currently amended) A server as recited in claim 22, wherein the request from the application program is <u>a registration request for the server to provide the at least a portion of the imaging operational metrics to the application program when the at least a portion of the imaging operational metrics are updated responsive to the imaging device performing imaging operations</u>, and wherein the communicating is performed automatically without the application program polling or querying the server device." (emphasis added)

For similar reasons as explained heretofore with regard to claim 31, the features of the present invention are not taught or suggested by the cited references in that the features of a registration request to receive/provide metrics when the metrics are updated are neither taught nor suggested by the Mathiesen reference in combination with the Garr and Murakami references.

Applicant respectfully traverses the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features

recited in the claims of Applicant's invention. Such could be possible only in hindsight and in light of Applicant's teachings. Therefore, the rejection of dependent claims 23 and 30 is improper at least for that reason and should be withdrawn.
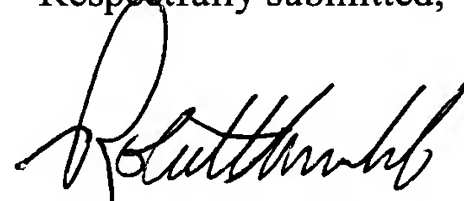
Conclusion

Attorney for Applicant has reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Robert C. Sismilich, Esq. at the below-listed telephone number.

AUTHORIZATION TO PAY AND PETITION
FOR THE ACCEPTANCE OF ANY NECESSARY FEES

If any charges or fees must be paid in connection with the foregoing communication (including but not limited to the payment of an extension fee or issue fees), or if any overpayment is to be refunded in connection with the above-identified application, any such charges or fees, or any such overpayment, may be respectively paid out of, or into, the Deposit Account No. 08-2025 of Hewlett-Packard Company. If any such payment also requires Petition or Extension Request, please construe this authorization to pay as the necessary Petition or Request which is required to accompany the payment.

Respectfully submitted,

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